

REMARKS

Claims 7, 9-11, and 13-22 remain pending in this application, with claims 7, 21, and 22 being independent. Claims 1-4 and 6 have been canceled without prejudice or disclaimer of subject matter. Claim 22 has been added.

Claims 1-4, 6, 7, 10, 11, and 13-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,786,513 to Cobben. Claims 9 and 21 were rejected under 35 U.S.C. § 103(a) as being obvious from Cobben in view of Kimura (JP 2000233561).

First, cancellation of claims 1-4 and 6 renders the rejections of those claims moot. While Applicants do not concede the propriety of the rejections, those claims have been canceled in an earnest effort to reduce the number of issues and advance the case to issue.

Applicants submit that independent claims 7, 21, and 22, together with the claims dependent therefrom, are patentably distinct from the cited references for at least the following reasons.

Claim 7 recites a security document including a carrier and a security feature with perforations in the carrier, wherein at least one of the perforations has an elongate cross section with a minimum and a maximum diameter, at least two of the perforations have different cross sections, the perforations extend through the carrier perpendicular to a surface of the carrier, and the cross sections have equal areas. By virtue of the features of claim 7, the different types of holes are indistinguishable when orthogonally viewing the carrier, but generate a difference when obliquely viewing the carrier. Nothing in Cobben would teach or suggest these features.

In the previous Amendment, Applicant pointed out the following:

The Office Action cites column 4, lines 10-15 and 44-47 of Cobben as teaching at least two perforations having different cross sections, and cites Figs. 3 and 4 as teaching the cross sections having equal areas. However, claim 7 requires, *inter alia*, perpendicular perforations, at least one of which is elongate. Fig. 3 of Cobben does not show perpendicular holes at all, and nevertheless shows holes with modulated widths, i.e., different diameters; while Fig. 4 shows perpendicular holes, there is nothing to indicate that those perpendicular holes are elongate. The cited portions of column 4 refer to an embodiment apparently having holes of *varied* area, unlike in claim 7, since (lines 10-15) the hole diameters are modulated, from which it follows that the areas of the holes are varied in the absence of any suggestion that the cross sections have equal area. Moreover, it is submitted that the Examiner has not made out a proper rejection on anticipation, since the Examiner appears to be picking and choosing from different embodiments of Cobben in order to find that claim 7 is anticipated by that patent. Even so, a security document having the features recited in claim 7 is not taught by Cobben.

In the *Response to Arguments* section, at page 7 of the Office Action, the Examiner states:

In the instant that the Cobben invention is made up of more than one perforation having an oval shape, then that cross section of that one perforation is indeed “different” than the cross section of another perforation, as broadly interpreted.

Applicants have carefully reviewed the Examiner’s statement, and, to the extent they understand it, completely disagree. It appears that the Examiner is interpreting the term “cross section” to refer to the physical hole of a perforation, such that two spatially separated perforations will always have “different” cross sections. However, the recitation in claim 7 “wherein at least two of the perforations have different cross sections” clearly refers to the shape of the perforations. The Examiner states that she is “broadly” interpreting the claims, but MPEP 2111 calls not for the “broadest interpretation” but for the “broadest reasonable interpretation,” and one that is consistent with the specification and with the interpretation that those skilled in the art would reach. (Emphasis added.) The present specification, for example, at page 5, lines 33-34, states that “In another embodiment, the holes have cross

sections of different shape.” Therefore, from the specification it is clear that the claim term “different cross sections” refers to the shape of the perforations. It is not reasonable under MPEP 2111 for the Examiner to interpret the claim recitation “different cross sections” such that any two spatially separated perforations -- even if shaped the same -- would have physically “different” cross sections. Applicants traverse the rejection on at least this basis.

Furthermore, along these lines, Applicants have now added claim 22, which is similar to claim 7 except that claim 22 recites “shape” instead of “cross section.”

For at least the foregoing reasons, claims 7 and 22 are seen to be clearly allowable over Cobben.

Claim 21 is directed to a security document comprising a carrier, a first type of perforations in the carrier having elongate cross section, and a second type of perforations in the carrier having circular cross section. The elongate cross section has an equal area as the circular cross section, and the first and second types of perforations extend through the document in a direction perpendicular to a surface of the carrier.

At page 7 of the Office Action, the Examiner states that “the Cobben invention is relied upon to teach the circular cross section and the Kimura invention is relied upon to teach the elongated cross section.”

Kimura may teach perforations with elongate cross section, and Cobben perforations with circular cross section. However, claim 21 further specifies that both cross sections should have equal area. Even if the teachings of Cobben and Kimura were combined (even though it is unclear for what motive), the prior art provides no reason why the two types of perforations should have equal cross section. In fact, a person having ordinary skill in the art would probably manufacture the perforations such that the smaller diameter of the elongate perforations is equal to the diameter of the circular perforations, such that both types of perforations can be manufactured with a single, circular laser beam which, during the

duration of a laser pulse, is moved along the paper (for the elongate perforations) or stationary (for circular perforations). For perforations manufactured in this manner, the elongate perforations would have larger area than the circular perforations.


For at least the foregoing reasons, claim 21 is seen to be clearly allowable over the Cobben and Kitamura, whether considered separately or in any permissible combination (if any).

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and its entry is therefore believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, she is respectfully requested to contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Respectfully Submitted



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